

### REMARKS

Claims 27-30, 33, 35, 37-39, 53-63, and 65 are pending. Claims 27-30, 33, 35, 37-39, 53-63, and 65 are amended to clearly define the patentable subject matter. Support for the amended claims can be found throughout the specification, particularly pages 2-5.

Amendment to claim 54 and 63 is to overcome 35 U.S.C. § 112. Favorable reconsideration is respectfully requested in light of the following remarks.

**1. Rejection of Claims 54 and 63 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph**

Applicants have amended claims 54 and 63 to obviate the rejection.

**2. Rejection of Claims 29, 30 and 58 under 35 U.S.C. § 112, first paragraph**

The Examiner's attention is directed to the response previously submitted by the Applicants' representative on October 13, 2006 wherein the same rejection is discussed in detail. However, Applicants submit herein the same discussion:

The rejection of Claims 29, 30, and 58 under 35 U.S.C. § 112, first paragraph, is traversed below. The Office is taking the position that the limitation stating that "the ink receptive layer, or a portion thereof, and the base layer, or a portion thereof, is not in contact" is not supported by the specification as originally filed. Applicants respectfully disagree on the basis that Figures 1-3 clearly depict that an embodiment of the invention in which the ink receptive layer (symbol 12, 14, or 16 in Figs 1-3), or a portion thereof, and the base layer (symbol 10 in Figs 1-3), or a portion thereof, are not in contact. The standard for satisfying written description requirements under 35 U.S.C. § 112, first paragraph is "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). See MPEP section 2163.02. Possession may be shown in a variety of

ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the Applicants were in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997); *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991). See MPEP section 2163.02.

In the present situation, the invention is shown as ready for patenting by the disclosure of the originally filed drawings, which satisfies the legal objective standard for positively demonstrating acceptable written description requirements under 35 U.S.C. § 112, first paragraph. Therefore, the Office's position contradicts all of the above-mentioned case law cited by MPEP section 2163.02. Accordingly, Applicants respectfully request this ground of rejection to be withdrawn.

**3. Rejection of Claims 27-30, 33, 35, 37-39, 53-59, 63 and 65 under 35 USC § 103(a) as being unpatentable over WO 99/63157 taken in view of Malhotra (USP 5,709,976).**

The independent claim 27 is amended to emphasis that this invention is directed to an uncoated paper or paperboard. As previously discussed, the ink receptive layer has at least one biocide; and a holdout layer that is disposed between the base layer and the ink receptive layer. The Examiner admits that WO 99/63157 fails to teach that the ink receiving layer has a biocide. Since, the WO 99/63157 is directed to a coated paper or paperboard and the present invention is directed to an uncoated paper or paperboard, then the amended claim 27 is not taught or described in WO 99/63157.

With respect to **Malhotra**, as noted by the Examiner, **Malhotra** is directed to a coated paper which includes a hydrophobic barrier layer where an image receiving coating situated on top of both hydrophobic barrier layers. Therefore, **WO 99/63157** or **Malhotra** neither alone nor in combination teach nor suggest the present claimed invention. Therefore, the amended claim 27 defines a patentable subject matter and claims 28-30, 33, 35, 37-39, 53-59, 63, and 65 are dependent directly or indirectly upon claim 27 and therefore inherit each and every element of the parent claim and any intervening claim(s). Applicants respectfully request withdrawal of this ground of rejection.

**4. Rejection of Claims 27-30, 33, 35, 37-39, 53-59, 63 and 65 under 35 USC § 103(a) as being unpatentable over Bailey et al (5, 885, 340).**

Again, as the Examiner noted, **Bailey et al** teaches a coated paper or paperboard comprises starch, and a second layer that comprises acrylic latex, biocide and other additives.

Accordingly, **Bailey et al** fails to disclose or suggest the claimed invention.

Applicants respectfully request withdrawal of this ground of rejection.

**5. Rejection of Claims 27-30, 33, 35, 37-39, 53-59, 63 and 65 under 35 USC § 103(a) as being unpatentable over Ogawa (5,472,757).**

With respect to **Ogawa**, it appears that Examiner suggests that Slimicide and biocide are the same chemical agent. Although it may be true that Slimecide and biocide may have some similarity in their function but one of the ordinary skilled in the art would appreciate that they are not the same. As defined by "Pulp & Paper Dictionary" by John R. Lavigne—

***Slimicide:** Toxic chemical substance added to the pulp and paper process to inhibit the growth of undesirable microorganisms that cause slime. (emphasis added)*

***Biocide:** Chemical substances used to prevent microbiological development in pulp and paper process materials.*

Moreover, in general, slimicide is used in the wet end papermaking machine to prevent the growth of damaging organisms within papermaking machine. In fact, slimeicide does not protect the paper or paperboard recited in the claimed of invention, but only protects the papermaking machine from the growth of damaging organisms. In the present invention, the Applicants apply biocide at the size press where biocide penetrates into the thickness of the paper as well as sits on the surface of the paper. The application of the biocide at the size press would entirely prevent the Mold and Mildew that would attack paper in the long run (number of years) where the paper stored in the facilities. Therefore, the **slimeicide** and **biocide** can not be used interchangeably with respect to the present claimed invention. The Applicants' invention provide a substantially inflexible paperboard material which may be used for file folders and other related storage articles and which exhibit improved durability and resistance to damage and staining if contacted with water during long-term (number of years) storage or with beverages such as coffee when in use in an office environment.

In sum, Ogawa describes a significantly different coated paper structure, intended for different purpose, which does not describe or suggest Applicants' claimed invention.

In light of the foregoing, Applicants urge the Examiner to reconsider the present invention, to withdraw the rejections, and to issue a notice of allowance at the earliest possible convenience.

CONCLUSION

Therefore, Applicants respectfully submit that the amended independent claim 27 particularly define and patentably distinguish the present invention over the cited references. In addition, all of the dependent claims which depend from claim 27 also define a patentable subject matter. Accordingly, reconsideration of the rejections and allowance of claims 27-30, 33, 35, 37-39, 53-63, and 65 is earnestly requested. However, should the Examiner have any remaining questions and the attending to of which would expedite such action, the Examiner is invited to contact the undersigned at the telephone number listed below.

One month extension of time is believed to be required. The Commissioner is authorized to charge any fees associated with this or any other communication, or credit any over payment, to Deposit Account No. 09-0525.

Respectfully submitted,

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